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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/760,878  | 01/17/2001  | Takahiko Kawashima   | 826.1664            | 4982             |
| 21171   | 7590        | 10/19/2006           | EXAMINER            |                  |
| STAAS & HALSEY LLP<br>SUITE 700<br>1201 NEW YORK AVENUE, N.W.<br>WASHINGTON, DC 20005 |             |                      | ZURITA, JAMES H     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3625                |                  |

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/760,878 | <b>Applicant(s)</b><br>KAWASHIMA ET AL. |  |
|                              | <b>Examiner</b><br>James H. Zurita   | <b>Art Unit</b><br>3625                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

On 17 January 2001, applicant filed the instant application, claiming priority to application 2000-176233, filed 13 June 2000 in Japan.

On 24 March 2004, the Examiner rejected claims 1-6.

On 26 July 2004, applicant filed a response, adding claims 7-14.

On 29 October 2004, the Examiner rejected claims 1-14 as unpatentable over Chang (US 6584459).

On 29 March 2005, applicant filed the present amendment, where he cancelled claim 3, amended claims 1, 4-14 and added claim 15.

On 17 June 2005, the Examiner rejected claims 1-2, 4-14 as unpatentable over Chang.

On 28 November 2005, Applicant requested reconsideration.

On 9 December 2005, the Examiner issued an Advisory Action.

On 28 December 2005, applicant requested continued examination.

On 21 March 2006, the Examiner rejected claims 1-2, 4-14 as unpatentable over Chang.

On 25 May 2006, applicant filed a notice of appeal.

On 25 July 2006, applicant filed an appeal brief.

### ***Response to Appeal Brief***

In view of the Appeal Brief filed on 25 July 2006, PROSECUTION IS HEREBY REOPENED. New Grounds of Rejection are set forth below.

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To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claims 1-2 and 4-14 are pending.

### ***Response to Arguments***

Applicant's arguments filed 26 July 2006 have been fully considered but they are not persuasive.

Applicant argues that the Examiner errs in interpreting the claims as having no support for extracting structure data such as ***XML tags, metadata***. Applicant cites alleged support from paragraphs 0033, 0034, 0050 and 0058 of his amended specifications of 29 March 2005. The cited paragraphs do not appear to support interpreting the claims as enabling extraction of XML tags, metadata.

### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 4-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-2, 4-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For purposes of examination, as best understood by the Examiner, the claims will be interpreted as being directed to:

- Receiving, at a central location, an input record (from a buyer, for example) that has a header portion and a "record" (i.e., detail) portion (Fig. 2). Each portion has data that is embedded in XML tags that define the structure of an XML DTD.
  - For each input record,
    - Extracting the embedded data from the header portion, storing it as "management" data;
    - Extracting the embedded data from the record portion and storing it as "transaction" data;
    - Correlating the management data and transaction data with a common identifier.
- Searching stored management data for particular contents (e.g., for company P, a buyer, as in Fig. 9)
  - For each record retrieved in the search of management data,
    - Obtaining the related transaction data via the common identifier.
    - Formatting the related transaction data into a format compatible with an intended recipient (e.g., a particular seller) according to conversion parameters.

### ***Claim Rejections - 35 USC § 102***

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2 and 4-14 are rejected under 35 U.S.C.102(e) as being anticipated by Chang (US 6,584,459).

Chang discloses an EDI/XML environment that manages documents containing data (applicant's transaction slip data documents) in electronic commerce, with database devices.

***As per claims 1, 6, 7 and 11***, Chang discloses:

- ***extracting*** structure data as a search item of the transaction slip data document therefrom. See, for example, at least Col. 20, lines 1-50. For transaction detail information extracted, see, for example, at least Col. 5, line 50-Col.6, line 15. Detail transaction data includes price, publication date, for example.
- ***storing*** the structure data extracted as management data in correlation with the transaction data; see, for example, at least Col. 20, line 55-Col. 21, line 15. See also management data, such as publisher, as in Col.5.
- ***searching*** the management data so as to extract correlated transaction slip data. See at least Col. 7, lines 45-67, Col. 21, line 16-Col. 22, line 40, Col. 23, line 52-Col. 25, line 60.
- ***transmitting*** the transaction slip data extracted [in the search step] over a network. See at least sending results to interfaces, at least Col. 5, line 12-Col. 6, line 45.

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- **receiving** the transmitted slip data. See, for example, at least Figs. 1, 2 and related text, and references to various units that receive transmitted detail data.
- **converting** a first format of the received transaction slip data into a second format based on a transmission destination, wherein
  - the first format of the received transaction slip data is usable by an order issuer (buyer) and the second format based on a transmission destination is usable by an order acceptor (seller) in an electronic business transaction between the order issuer and order acceptor without requiring a tailoring of servers of the order issuer and the order acceptor. See, for example, Fig. 2, DB2 XML extender, which converts data to and from formats used by other systems and parties.

**As per claim 2**, Chang discloses that correlation between data is managed with a key that is common. See, for example, at least references to DocId, Index, Key, RID, at least Fig. 4, 6, 12-13 and related text. See also at least Col. 19, line 1- Col. 20, line 50. See also references to primary keys, foreign keys, DTDId, and other keys that correlate data among the various data objects, at least Col. 13, line 1-Col. 15, line 48.

**As per claim 4** Chang discloses that users are allowed to define new searches for retrieval of XML documents. See, for example, Col. 6, lines 19-45.

**As per claim 5**, Chang discloses

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- that the document containing transaction data is an XML document. See, for example, at least Col. 2, line 18-Col. 3, line 24, Col. 3, line 47-Col. 4, line 18, Figs. 3, 8, 9 and related text.
- that users are allowed to define new searches for retrieval of XML documents. See, for example, at least Col. 6, lines 38-45, Col. 7, line 54-Col. 8, line 3. As per claims 5, 10 and 14, a user may alter targets of a search by changing a search query according to particular tags found in XML documents, such as an author tag in XML document of Col. 5 that is used as a search parameter in the query found in Col. 20.

**Claim 6** is rejected on the same grounds as claim 1.

**Claim 7** is rejected on the same grounds as claim 1.

**As per Claim 8**, Chang discloses changing the structure data of a document to be considered including the management data. Chang discloses that users may define new searches by changing search parameters such as management data. See, for example, at least Col. 6, lines 38-45, Col. 7, line 54-Col. 8, line 3.

**Claim 9** is rejected on the same grounds as claim 5.

**Claim 10** is rejected on the same grounds as claim 5.

**Claim 11** is rejected on the same grounds as claim 1.

**Claim 12** is rejected on the same grounds as claim 8.

**Claim 13** is rejected on the same grounds as claim 5.

**Claim 14** is rejected on the same grounds as claim 5.



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**Conclusion**

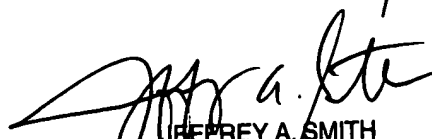
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**James Zurita**  
**Primary Examiner**  
**Art Unit 3625**  
10 October 2006

*James Zurita*  
*Primary Examiner*

  
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